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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,426	12/22/2000	Hiroshi Matsuda	250-827	8033

7590 02/07/2002

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

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DATE MAILED: 02/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/742,426

Applicant(s)

MATSUDA, HIROSHI

Examiner

Callie E. Shosho

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17 2(a))  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 & 3 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

**Information Disclosure Statement**

1. It is noted that JP 06049401 has been stricken from the IDS filed 8/14/01, Paper No. 3, as redundant given that it is also cited on the IDS filed 12/22/00, Paper No.1

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by either Asada (U.S. 6,165,258) or Okuda et al. (U.S. 6,190,444).

Asada discloses a stencil printing water-in-oil emulsion ink comprising carboxyvinyl polymer including 0.5-15% acrylic resin and 0.1-2% sodium borate, i.e. borax. It is disclosed that the ink comprises 10-90% water phase and 10-90% oil phase (col.1, lines 5-6, col.1, line 66- col.2, line 1, col.6, lines 37, 40-43, and 55-56, and col.7, line 6).

Alternatively, Okuda et al. disclose a stencil printing water-in-oil emulsion ink comprising 0.5-30% carboxyvinyl polymer such as maleic acid resin and borax. It is disclosed that the ink comprises 10-90% water phase and 10-90% oil phase (col.1, lines 3-6 and 51-53, col.2, lines 34-37, 56, and 61-63, and col.3, line 61). The monovalent metal salts present in the ink include borax. From the examples, it is noted that the monovalent salt is present in the ink in amounts ranging from 0.5-0.8%.

In light of the above, it is clear that either Asada or Okuda et al. anticipate the present claims.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al. (U.S. 5,948,151).

Ono et al. disclose a stencil printing water-in-oil emulsion ink comprising 1-20% carboxyvinyl polymer such as polyacrylate and sodium tetraborate, i.e. borax. From example 2, it is noted that borax is present in the ink in an amount of 0.5%. It is also disclosed that the ink comprises 30-90% water phase and 10-70% oil phase (col.1, lines 2-3 and 49-51, col.2, lines 3-4 and 66, col.3, lines 60-63, and example 2).

In light of the above, it is clear that Ono et al. anticipates the present claims.

5. Claims 1 and 4-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohshima et al. (U.S. 6,063,835).

Ohshima et al. disclose a stencil printing water-in-oil emulsion ink comprising 0.1-5% carboxyvinyl polymer such as polyacrylic acid and derivatives such as sodium polyacrylate. It is

disclosed that the ink comprises 60-80% water phase and 20-40% oil phase (col.3, lines 27-33 and 42-45, col.7, lines 49-53, and col.8, lines 16-17).

In light of the above, it is clear that Ohshima et al. anticipates the present claims.

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al. (U.S. 4,585,815).

Ono et al. disclose a stencil printing water-in-oil emulsion ink comprising 0.5-5% carboxyvinyl polymer such as sodium polyacrylate (col.1, lines 5-6 and col.2, lines 30-31 and 35-37).

In light of the above, it is clear that Ono et al. anticipate the present claims.

7. Claims 1 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 06049401.

Pending written translation of the Japanese reference, it is noted that JP 06049401 discloses a stencil printing emulsion ink comprising carboxyvinyl polymer that are water-soluble polymers such as acrylic acid resin or sodium polyacrylate. It is disclosed that the ink comprises 50-90% water phase and 10-50% oil phase (abstract). The table on page 4 discloses that the ink contains 0.05-1.5% water-soluble polymer (last row of table).

In light of the above, it is clear that JP 06049401 anticipates the present claims.

**Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohshima et al. (U.S. 6,063,835), Ono et al. (U.S. 4,585,815), or JP 06049401 any of which in view of Asada (U.S. 6,165,258).

The disclosures with respect to Ohshima et al., Ono et al, and JP 06049401 in paragraphs 5, 6, and 7, respectively, are incorporated here by reference.

The difference between Ohshima et al., Ono et al, or JP 06049401 and the present claimed invention is the requirement in the claims of borax.

Asada, which is drawn to stencil printing emulsion ink, disclose the use of 0.1-2% sodium borate, i.e. borax, as an emulsion stabilizer (col.6, lines 31, 37, and 40-43).

In light of the motivation for using borax disclosed by Asada as described above, it therefore would have been obvious to one of ordinary skill in the art to use borax in the ink of either between Ohshima et al., Ono et al, or JP 06049401 in order to improve the stability of the ink, and thereby arrive at the claimed invention.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Asada (U.S. 6,156,109) is identical to Asada (U.S. 6,165,258) described in paragraph 2 above in that it discloses stencil printing water-in-oil emulsion ink comprising 0.5-15% carboxyvinyl polymer and 0.1-2% borax and wherein the ink comprises 10-90% water phase and 10-90% oil phase.

Koike et al. (U.S. 5,378,739) disclose stencil printing water-in-oil emulsion ink comprising maleic acid resin.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

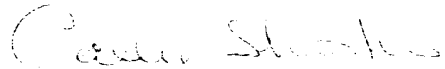
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Callie E. Shosho  
Examiner  
Art Unit 1714



Callie Shosho  
February 5, 2002